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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

IMP-102

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Application Number

10/668,805

Filed

September 24, 2003

First Named Inventor

Maurice Valen

Art Unit

3732

Examiner

Candice Capri Stokes

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 29,188

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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1/31/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 3 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/668,805 Conf. No. 4324
Applicant : Maurice Valen
Filed : September 24, 2003
TC/A.U. : 3732
Examiner : Candice Capri Stokes
Docket No. : IMP-102
Title : UNIVERSAL, MULTIFUNCTIONAL, SINGLE
UNIT, ROTARY OSTEOTOME
Customer No. : 41245

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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S I R:

A pre-appeal brief review of the above-identified patent application is hereby respectfully requested, due to factual deficiencies in Examiner Candice Stokes' rejections. This case stands finally rejected.

Claims 1 - 2 and 4 - 28 stand rejected under 35 U.S.C. §103(a) as being obvious over United States Patent No. 6,364,662 for DIAMOND-LIKE CARBON COATED DENTAL INSTRUMENT, issued April 2, 2002 to Ajay Kumar in view of United States Patent No. 5,139,098 for COMBINED DRILL AND UNDERREAMER TOOL, issued August 18, 1992 to John Blake. Claims 1 - 29 remain in the case.

The claims of the present invention are drawn to a single, one-piece, multifunctional, surgical, rotary instrument to be used in cooperation with a surgical dental motor driven handpiece for preparing an osteotomy for insertion of implant. Applicant's novel tool combines the functions of six individual known surgical instruments into one rotary tool. The inventive device has structural features rigidly affixed to one another forming a unitary device that provides the functions of a crestal bone height reducer, an osteotomy locator, an osteotomy lateral redirector, an osteotomy drill, a tapered countersink, and an osteocompressor. These structural features include a dual-lobed, single plane tip that remains where the drilling is initiated without wandering, thereby facilitating maintaining a precise location for the osseous implant site. Unlike some multifunction dental tools of the prior art, there are no moving or interchangeable parts in Applicant's novel tool; all functions associated with each of the aforementioned structural features are accomplished without adding to, deleting from, or moving any portion thereof.

Claims 1 - 2 and 4 - 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over KUMAR in view of BLAKE. Applicant's amendment filed May 5, 2006 overcame the Examiner's previous rejection of claims 1 - 2 and 4 - 28 under 35 U.S.C. §102(b) as being anticipated by KUMAR. In his response thereto, Applicant amended claims 1 and 15 to recite a single tool including the disclosed structural features. However, the Examiner has now issued a rejection of the same claims under 35 U.S.C. §103(a) as being obvious over KUMAR in view of BLAKE. Applicant's amendment dated October 31, 2006 amended claims 1 and 15 to recite a one-piece tool including the disclosed structural features. However, the Examiner refused to enter the amendment on the basis that it was submitted after a final rejection.

BLAKE teaches a dual-purpose dental tool wherein a drill portion has a hollow central portion within which a selectively deployable underreaming apparatus is disposed. Upon actuation, the underreaming apparatus is released from the central portion and is allowed to expand outwardly therefrom to accomplish its intended purpose. A fluid stream

is effectively blocked and unblocked to activate and deactivate the underreamer. The Examiner has combined BLAKE with KUMAR to attempt to obviate Applicant's single, one-piece, multi-function osteotome.

The burden of establishing a *prima facie* case of obviousness falls upon the Examiner. Therefore, the evidence upon which the Examiner relies must clearly indicate that a worker of routine skill in the art would view the claimed invention as being obvious, as required by 35 U.S.C. §103. Ex parte Wolters and Kuypers, 214 USPQ 735 (PTO Bd. App. 1979). The Examiner has clearly failed to satisfy that burden here.

If more than one reference is relied upon to support a finding of obviousness, every element of the invention must be found within the combination of the references. There must also be a motivation or suggestion to combine the references. See In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 1996).

There can be no finding of obviousness here since at least one indispensable element is missing from both of the combined prior art references. KUMAR or BLAKE, neither individually, nor in combination, teach or suggest Applicant's "osteotomy locator tip having dual lobes disposed in a common plane, formed at said distal end of said cutting and drilling blade" (Claim 1(d)). Rather, KUMAR teaches a multi-lobed, multi-planar distal tip known to wander when using a handheld instrument, therefore making maintenance of the precise location of the osseous implant site difficult. BLAKE is silent regarding an osteotomy locator tip.

Furthermore, there can be no finding of obviousness here because even if assuming *arguendo*, all the elements were present in the combination of BLAKE and KUMAR, there is no suggestion or motivation to combine. When prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. Uniroyal Inc. v. Rudkin Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). The Examiner must show that there is either a suggestion in the art to produce

the claimed invention or a compelling motivation based on sound scientific principles. Ex parte Kranz, 19 USPQ2d 1216, 1218 (B.P.A.I. 1990); see Kahn, 441 F.3d at 986. BLAKE fails to teach or suggest a multi-functional tool having NO moving parts, or in other words, "a one-piece device" (claim 1), as taught and proposed to be claimed by Applicant in his un-entered amendment. BLAKE'S apparatus has at least two pieces - "an elongated cylindrical body member" and "an underreamer device" (claim 1).

If the function of one of the references must be modified so as to render the original function of the claimed apparatus inoperative, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Certainly removing or fixing the movable components of the BLAKE apparatus to form a solid, one-piece device such as that taught and claimed by Applicant, would render the BLAKE underreamer inoperable. Portions of the BLAKE movable underreamer MUST move outwardly from within the confines of the hollow central region of the drill to perform its intended underreaming function. Therefore, there is no suggestion to combine KUMAR and BLAKE because in combination, the hypothetical device would be inoperable.

In his un-entered amendment, Applicant has proposed to amend claims 1 and 15 to recite a single, one-piece, multi-function rotary tool bit, to overcome the rejection of claims 1, 2 and 4 - 28 under 35 U.S.C. §103(a) as being unpatentable over KUMAR in view of BLAKE.

Claims 3 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over KUMAR. Claims 3 and 17 merely recite an additional limitation to the base claims that Applicant believes would be rendered allowable if his un-entered amendment were entered. Consequently, the proposed amendment

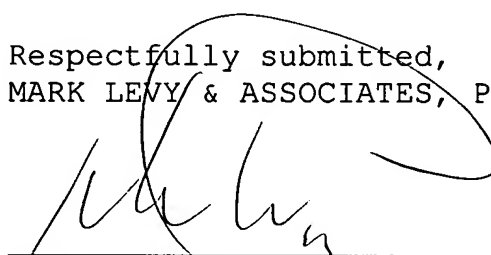
of claims 1 and 15 also overcomes the rejection of claims 3 and 17.

In view of the foregoing remarks, the Honorable panel is respectfully requested to reverse the rejection of claims 1 - 2 and 4 - 28, and to allow the subject application to issue as a patent.

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